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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,656	02/25/2002	Nouri E. Hakim	4009.007.201	9483
7590	08/05/2005			
Morris E. Cohen 1122 Coney Island Avenue, Suite 217 Brooklyn, NY 11230-2345			EXAMINER GROSSO, HARRY A	
			ART UNIT 3727	PAPER NUMBER

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/083,656

Applicant(s)

HAKIM, NOURI E.

Examiner

Harry A. Grosso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-27 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Terminal Disclaimer***

1. The terminal disclaimer filed on December 7, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,321,931 B1 or US 6,357,620 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the anti-inversion member (claim 26) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 15 recites the limitation "said post" in line 1. There is insufficient antecedent basis for this limitation in the claim. This claim is dependent on claim 11 but it appears that it is intended to be dependent on claim 13 and will be read this way for purposes of examination.

6. Claim 17 recites that the valve begins to invert upon application of negative pressure it is unclear how the entire valve would invert in view of the valve function described in claim 16, on which claim 17 is dependent.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-5 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Green (5,651,471).

9. Regarding claim 1, Green discloses a valve with a protruding member (32, Figures 8-9), an opening (35) and the protruding member extends through the opening when the valve is closed and is separated from it when open.
10. Regarding claim 3, Green discloses a cap for a cup (column 2, lines 54-56).
11. Regarding claim 4, Green discloses a drinking cup (50 Figure 1, column 3, lines 51-52)
12. Regarding claim 5, Green discloses a valve assembly (30, column 3, lines 57-58).
13. Regarding claim 16, Green discloses a sealing member with a protruding member and a base (32), a valve member (30) which would inherently have some flexibility and the valve member is proximal the base when the valve is closed (Figure 9) and is distal to the base when the valve is open (Figure 8).
14. Claims 1, 3-5, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Forrer (5,607,073).
15. Regarding claim 1, Forrer discloses a valve with a protruding member (18, Figures 1, 4, 5), an opening (14) and the protruding member extends through the opening when the valve is closed and is separated from it when open.
16. Regarding claims 3-5, Forrer discloses a cap (21), a drinking cup (22) and a valve assembly (10, Figure 1, column 2, lines 3-6).
17. Regarding claim 16, Forrer discloses a sealing member with a protruding member (18) and a base (16), a valve member (13) which would inherently have some

flexibility, and the valve member is proximal the base when the valve is closed (Figure 2) and is distal to the base when the valve is open (Figure 4).

18. Regarding claim 17, the claim recites that the valve begins to invert upon application of negative pressure. Forrer discloses an element of the valve begins to invert upon application of negative pressure (Figure 4, column 2, lines 28-32).

19. Claims 1 and 3-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Miles (2,584,359)

20. Regarding claims 1 and 6, Miles discloses a valve with a protruding member (14, Figure 8, column 3, lines 55-60), an opening (1) and the protruding member extends through the opening when the valve is closed and is separated from it when open, and the valve is moved from the closes to open position by application of negative pressure (column 3, lines 11-15).

21. Regarding claims 3-5 and 7-10, Miles discloses a cap (5), a cup (4) and a valve assembly (2 and 14, Figure 8) and the valve assembly is attached to the cap (Figure 1).

22. Regarding claims 11 and 12, Miles discloses a sealing member comprising a protruding member (14) and a base (shown in Figure 1, column 3, lines 55-60) with the base approximately flat.

23. Regarding claims 13-15, Miles discloses the protruding member is a post with a tapered/conical tip.

***Allowable Subject Matter***

24. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Double Patenting***

25. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

26. Claims 6-15 and 18-27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 and 13-22 respectively of prior U.S. Patent No. 6,357,620. This is a double patenting rejection.

***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baron et al (5,433,328) and Arisland (4,135,513) disclose a valve with a protruding member and a valve member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan Newhouse  
Supervisory Patent Examiner  
Art Unit 3727

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